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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,266	03/29/2004	Melissa Silvestro	EMC-012 (EMC-04-014)	2765
60/567 7590 07/01/2008 GUERIN & RODRIGUEZ, LLP 5 MT. ROYAL AVE. MARLBORO, MA 01752				
EXAMINER				
SAUTHER, FLEMING				
ART UNIT		PAPER NUMBER		
3677				
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07/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,266

Applicant(s)

SILVESTRO ET AL.

Examiner

Flemming Saether

Art Unit

3677

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In response to the remand from the Board of Appeals, claims 1, 2 and 9 are now rejected under 35 U.S.C. 103(a) as being unpatentable over applicants admitted prior art (APA) in view of US Patent No. 6,746,193 issued to Drake and further in view of US patent No. 6,578,939 issued to Mayer. The APA discloses that it is known to use screws in combination with round type Electronics Industry Association Standard mounting rail and, square type Universal Mounting rail according to NEMA standards but, concedes that separate screws would be required for each type of mounting. Drake teaches to provide a shoulder (110) to a fastener such that the same fastener could be used in either a round type or square type mounting rail. The shoulder being sized to fit closely with the square hole (see Fig. 6) and rest upon the surface of the surface of the round hole. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the screw of the APA with a shoulder as disclosed in Drake for the same economic reasons as described therein. As noted by the board of appeals, Drake does not disclose the stepped portion being circular but, in turn cited the reference to Mayer for consideration. In that regard, Mayer also discloses fastener for use in rail type mounting systems (see Fig. 7), but in Mayer a stepped portion (800) is shown to be circular (see Fig. 7). At the time the invention was made, it would have

been obvious for one of ordinary skill in the art to make the stepped portion of the modified APA circular as disclosed in Mayer because the shape of Drake's stepped portion in only "*preferably square*" [italic added] it leaves open the possibility of other shapes and the circular shape a disclosed in Mayer is one of a group of alternative shape in the same environment which would be providing predictable results. Once the combination was made, the shoulder would be with the claimed dimensions in order to fit closely within the square opening.

Response to Remarks

After consideration of applicant's remarks, the rejection remains unchanged.

Applicant argues that the BPAI, in suggesting the combination of the APA, Drake and Mayer, did not make a determination as to the obviousness of the rejection. In response the examiner agrees but, since the BPAI suggested the combination the examiner will allow the BPAI to determine its obviousness also.

Applicant argues that the combination of he APA and Drake would not have been obvious. Specifically, applicant argues that "economic reasons" is not a proper motivation for combining the shoulder of Drake onto the screw head of the APA. In response the examiner disagrees because both the APA are Drake are from the same field of endeavor and Drake makes it clear that a shoulder would be an improvement to the fastener in that same field of endeavor. The advantages provided would be mostly

economic in that it would do away with "and extremely wasteful process" and be "cost effective" (Drake's Background of the Invention).

Furthermore, in considering KSR (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007)) it has been determined that following rational are support for obviousness (MPEP 2143):

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) " Obvious to try " – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As applied to the facts of the instant application, it appears that each of rationales may be applicable but, rational (C) probably best applies to the combination of the APA and Drake. Both the APA and Drake are similar devices for mounting rack mounted equipment and Drake teaches to improve the device by doing away with "an extremely wasteful process" and the improvement, the shoulder, would be applied to the APA in the same way. As to the combination of the APA, Drake and Mayer, rational (E) probably best applies because there number of different shapes the shoulder may have and Mayer discloses the circular shape which would have been "obvious to try" with a reasonable expectation of success since Mayer too is from the same field of endeavor.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Flemming Saether
Primary Examiner
Art Unit 3677

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